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PPLICATION NO	).	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,792	10/689,792 10/20/2003		Larry Neil Lewis	132913-1	7574
6147	7590	11/28/2005	EXAMINER		INER
		TRIC COMPANY	THOMPSON, CAMIE S		
GLOBAL RESEARCH PATENT DOCKET RM. BLDG. K1-4A59 NISKAYUNA, NY 12309			ART UNIT	PAPER NUMBER	
			1774		
				DATE MAILED: 11/28/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)					
	10/689,792	LEWIS ET AL.					
Office Action Summary	Examiner	Art Unit					
	Camie S. Thompson	1774					
The MAILING DATE of this communication app Period for Reply	pears on the cover sheet with the	correspondence address					
A SHORTENED STATUTORY PERIOD FOR REPL' WHICHEVER IS LONGER, FROM THE MAILING D.  - Extensions of time may be available under the provisions of 37 CFR 1.1 after SIX (6) MONTHS from the mailing date of this communication.  - If NO period for reply is specified above, the maximum statutory period of Failure to reply within the set or extended period for reply will, by statute Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATIO (36(a). In no event, however, may a reply be ti will apply and will expire SIX (6) MONTHS from a cause the application to become ABANDONI	N. imely filed not the mailing date of this communication. ED (35 U.S.C. § 133).					
Status							
1) Responsive to communication(s) filed on	·						
•	action is non-final.						
3) Since this application is in condition for allowa	☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is						
closed in accordance with the practice under E	Ex parte Quayle, 1935 C.D. 11, 4	53 O.G. 213.					
Disposition of Claims							
4)⊠ Claim(s) <u>1-110</u> is/are pending in the application	n.						
, _ , , _ , , , , , , , , , , , , , , ,	4a) Of the above claim(s) is/are withdrawn from consideration.						
5) Claim(s) is/are allowed.							
6) Claim(s) is/are rejected.							
7) Claim(s) is/are objected to.	•						
8) Claim(s) <u>1-110</u> are subject to restriction and/or	r election requirement.						
Application Papers							
9) The specification is objected to by the Examine	er.						
10) The drawing(s) filed on is/are: a) acc	epted or b) objected to by the	Examiner.					
Applicant may not request that any objection to the	drawing(s) be held in abeyance. Se	ee 37 CFR 1.85(a).					
Replacement drawing sheet(s) including the correct	tion is required if the drawing(s) is of	bjected to. See 37 CFR 1.121(d).					
11)☐ The oath or declaration is objected to by the Ex	kaminer. Note the attached Office	e Action or form PTO-152.					
Priority under 35 U.S.C. § 119							
12) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of:	priority under 35 U.S.C. § 119(a	a)-(d) or (f).					
1.☐ Certified copies of the priority document	s have been received.						
2. Certified copies of the priority document	s have been received in Applicat	tion No					
3. Copies of the certified copies of the prior	rity documents have been receiv	ed in this National Stage					
application from the International Bureau	u (PCT Rule 17.2(a)).						
* See the attached detailed Office action for a list	of the certified copies not receive	ed.					
Attachment(s)	<del></del>						
1)	4) Interview Summan Paper No(s)/Mail D						
Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date		Patent Application (PTO-152)					

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## **DETAILED ACTION**

## Election/Restrictions

- 1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - Claims 1-28 and 51-80, drawn to an electro-active device, classified in class 313, subclass 506.
  - II. Claims 29-50, drawn to a metal containing layer, classified in class 428, subclass209.
  - III. Claims 81-110, drawn to a method of forming a metal-containing layer on a surface of a substrate, classified in class 427, subclass 66.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd-paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as substrate and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of

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the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions, the method of forming a metal containing layer on a substrate is a completely different invention from that of an electro-active device. An electro-active device is a product and different from the steps required to manufacture a metal containing layer.

Inventions II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be

used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the steps involved in manufacturing a metal containing layer can be different from the steps in the present invention. The organometallic complex can be dissolved in a solvent and then apply the dissolved organometallic complex onto the surface without decomposing the complex.

- 3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
- 4. A telephone call was made to Robert P. Santandrea on November 10, 2005 to request an oral election to the above restriction requirement, but did not result in an election being made.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Camie S. Thompson whose telephone number is (571) 272-1530. The examiner can normally be reached on Monday through Friday from 7:30 am to 4:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena L Dye, can be reached at (571) 272-3186. The fax phone number for the Group is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SUPERVISORY PATENT EXAMINER

A.U. 1774 "lailos